

Serial No. 09/900,787

- 2 -

21909sh

the location of surface positions accessible by the marking implement." To address this limitation, the Examiner points to Figure 2, and the specification at column 3, lines 41-65. However, Figure 2 is a block diagram, and column 3, lines 41-65 discusses the hardware. Pointing to particular structural elements, even if they could perform a particular function, falls short of anticipating a method step. It is well settled that, in order to anticipate, the reference must show each and every element of an invention as claimed. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In this case, a "microprocessor" or other electronic circuit does not "disclose" any method.

Claim 1 further includes a limitation of "moving at least a marking implement relative to the visual options for selection purposes." Again, the Examiner points to certain hardware which, presumably, the Examiner assumes could perform the stated function, also citing column 2, lines 60-67 which discuss the way in which, according to the '000 patent, an operator may move a pen to write set points onto the chart paper. Thus, a marking implement is not moved relative to visible options for selection purposes, since the visual options are not yet there.

Finally, claim 1 includes the limitation of "programming the instrument by correlating the position of the implement during the movement thereof to determine the options selected." Here, the Examiner points to column 1, lines 55-67 which discusses only the fact that set points may be programmed into a chart recorder and made visible on the chart recorder paper. Again, this has nothing to do with selecting existing options, but rather, involves a technique whereby predetermined set points are made visible. For all of the reasons set forth above, claim 1 of the instant invention clearly distinguishes over the '000 patent.

Claim 11 is similar in scope to claim 1, but includes the limitation of "moving at least the pen

Serial No. 09/900,787

- 3 -

21909sh

relative to the printed parameters so as to select certain of the parameters by marking the chart with the pen." There are no "printed parameters" disclosed in the '000 patent which would be applicable to this claim. Anticipation is precluded for this reason only.

Claims 10 and 16 stand rejected under 35 U.S.C. §103(a) over Levine in view of Ishiguro and further in view of Watanabe. However, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembicza, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, the Examiner has failed to establish *prima facie* obviousness. It must be kept in mind that claim 10 includes all of the limitations of claim 1, and that claim 16 includes all of the limitations of claim 11. For the reasons set forth above, Applicant disagrees that Levine ('000) discloses the method of programming an instrument with respect to claim 1 and claim 11. Including the limitations of claim 1 and claim 11 into claims 10 and 16, respectively, the Levine/Ishiguro/Watanabe combination does not render claims 10 and 16 obvious. First, there is no teaching or suggestion *from the prior art* as to the combination of elements in relation to claims 10 and 16, and even if there were such a teaching or suggestion, the inventions of claims 10 and 16, in combination, would not be the result. Furthermore, given that the inventions of Ishiguro and Watanabe are directed to entirely different subject matter, these represent non-analogous references, and do not apply in this case.

Serial No. 09/900,787

- 4 -

21909sh

Based upon the foregoing, Applicant continues to believe that all claims are in condition for allowance. Questions regarding this application can be directed to the undersigned at the telephone/facsimile numbers provided.

Respectfully submitted,

By:

~~John G. Fosa~~

~~Reg. No. 37,424~~

~~Gifford, Krass, Groh, Sprinkle,  
Anderson & Citkowski, PC~~

~~280 N. Old Woodward Ave., Ste 400~~

~~Birmingham, MI 48009~~

~~(734) 913-9300 FAX (734) 913-6007~~

Date: Sept. 19, 2002

FAX COPY RECEIVED

SEP 19 2002

TECHNOLOGY CENTER 2800